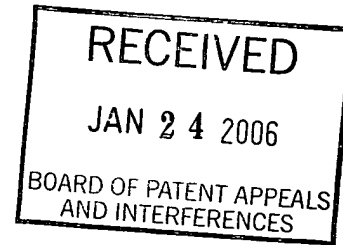




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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: Mark A. Voves
SERIAL NO.: 10/786,687
TITLE: PUNCH HOLDER AND STORAGE TOOL
FILED: February 25, 2004
GROUP/A.U.: 3724
Confirmation No.: 3013
EXAMINER: Jason D. Prone
Docket No.: P06555US1



Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This is an appeal from the rejection of claims 1 and 4-7 dated September 14, 2006.

I. Real Party In Interest:

The real party in interest of the instant appeal is Mark A. Voves, an Iowa citizen, having an address of 718 Yankee Avenue, Cresco, Iowa 52136.

II. Related Appeals and Interferences:

There are no related appeals or interferences.

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CERTIFICATE OF MAILING (37 C.F.R. § 1.8(A))

I hereby certify that this document and the documents referred to as enclose therein are being deposited with the United States Postal Service as First Class mail addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, Alexandria, VA 22313-1450, on this 20th day of January 2006.

Timothy J. Zarley

III. Status of the Claims:

Claims 1 and 4-7 are pending in this application and appear in Appendix A of this brief.

IV. Status of Amendments:

No amendments to the claims have been made since the last office action.

V. Summary of Claimed Subject Matter:

Both independent claims 1 and 5 are for a punch holder 10 having an elongated body 12 with a forward end 14 with a first enclosed compartment 18 having a size and shape to receive a shank 24 of an elongated punch. (Page 2, lines 24-29). The holder 10 also has a plunger 34 slidably mounted in the body 12 and having a forward end 36 in the enclosed compartment 18. (Page 3, lines 3-11).

The holder 10 additionally has a spring 40 associated with the plunger 34 disposed within a second compartment 30 and yieldingly urging the plunger 34 into the enclosed first compartment 18. (Page 3, lines 3-11). Additionally, the punch holder has an elongated slot 31 within its body 12. (Page 3, lines 1-2).

The next feature of the holder is a handle 44 that is secured to one end of the plunger 34 and extends outwardly through the slot 31 to permit manual grasping thereof to pull the plunger 34 rearwardly against the spring 40 to release the punch shank 24 from engagement with the plunger 34, or to permit the placement of a punch within the enclosed compartment 18 in the path of a forward end of the plunger 34. (Page 3, lines 15-24). According to claim 5 the punch holder 10 additionally has a threaded plug 42 that engages

the spring 40 to adjust the compression of the spring 40.
(Page 3, lines 3-11).

Independent claim 1 also requires a third storage compartment 48 disposed within the body 12 for receiving a plurality of punches. (Page 3, lines 12-14). Claim 1 also requires wherein the second compartment 30 is defined by first and second transverse walls 26, 28 wherein the first transverse wall 26 separates the first and second compartments 18, 30. (Page 2, line 30-page 3, line 14). The second transverse wall 28 separates the second and third compartments 30, 48. (Page 2, line 30-page 3, line 14).

VI. Grounds of Rejection to be Reviewed on Appeal:

The Examiner has rejected claims 1 and 7 under 35 U.S.C. § 103(a) over Le Grand (U.S. Pat. No. 1,196,252) in view of Wang (U.S. Pat. No. 6,305,249). Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Wang as applied to claim 1 above, and further in view of Wyler et al. (U.S. Pat. No. 3,933,148). Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Wyler et al. Claim 6 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Wyler as applied to claim 5 above and further in view of Wang.

VII. Argument:

A. Description of the Prior Art

Le Grand (U.S. Pat. No. 1,196,252)

Le Grand teaches a chisel and punch holder having a hollow handle 10 with an elongated slot 11 therein. (Col. 1, lines 41-44). Surrounding a plunger 18 is a spring 19 which normally urges the plunger forward and has a guide head 17

that will hold a punctured chisel 20. (Col. 1, line 50-Col. 2, line 60). Le Grand does not teach multiple compartments that are separated by transverse walls such as storage compartments or a compartment which houses a threadable plug to adjust the spring tension on the plunger.

2. Wang (U.S. Pat. No. 6,305,249)

Wang teaches an adjustable wrench that has a body 2 with a clamping portion 23. (Col. 2, lines 32-40). Within the body 2 is a sliding trough 25 with two slots and a hollow compartment 27. (Col. 2, lines 44-47). The wrench also has push piece 54 of pressing piece 5 that is pressed to disengage the teeth 53 of the ratcheting block 52 from teeth 31 of sliding block 3 such that then the first flexible element 35 will retract to pull back the sliding block 3 for the micro-adjustment 4 to automatically return to its previous location. (Col. 3, lines 32-38). Additionally, Wang teaches a hollow space 27 in body 2. (Col. 3, lines 9-11). The Wang reference does not teach three separate compartments that are separated by transverse walls such that the third compartment is a storage compartment and the second compartment has an adjustable plug for adjusting the tension on a spring.

3. Wyler et al. (U.S. Pat. No. 3,933,148)

Wyler teaches a device for determining the degree of skin sensitivity on the basis of persistence of a streak. (See Abstract). The device has a housing 1 that houses an axially displaceable pressure rod 2 and a coil spring 4 that can be adjusted by a means of an adjusting screw 5. (Col. 2, lines 30-41). The Wyler reference does not teach a punch holder or multiple compartments separated by transverse walls such as a storage compartment nor a second compartment having

an adjustable plug for adjusting the spring tension in a holder.

B. Argument In Support of Reversal

Rejection under 35 U.S.C. § 103

The Examiner has rejected claims 1 and 7 under 35 U.S.C. § 103 as being unpatentable over Le Grand in view of Wang. Applicant first asserts that there is no teaching or motivation within Wang to combine Wang with the Le Grand reference to arrive at the claimed invention. An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

The obvious rejection asserted by the Examiner is based on a combination of prior art references, e.g., the punch holder of Le Grand combined with the adjustable wrench of Wang. To justify this combination the Examiner states "therefore it would have obvious to one of ordinary skill in the art, to have provided Le Grand with a third storage compartment, transverse side walls, and a frusto-shaped enclosed first compartment, as taught by Wang for added convenience so the user can have all the necessary tools at his/her disposal and not interfere with the components of the apparatus, to prevent the plunger and the spring from moving side to side and to allow, and to allow the tool to conform to the old and well known shape of most shanks." Upon review of Wang, Wang does not teach or provide motivation for any of these advantages. Thus, rather than pointing to specific information in Wang that suggest the combination with the punch holder of Le Grand, the Examiner has described the general functions of the Wang wrench. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references such as the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other facts or findings that might serve to support a proper obviousness analysis. See, e.g., Pro-Mold & Tool, 75 F.3d 1568, 1573, 37 U.S.P.Q.2d. 1626, 1630 (Fed. Cir. 1996).

To the contrary, the Examiner's decision is based on the discussion of ways that the multiple prior art references can be combined to read on the claimed invention. (Final Office Action pages 2-3). Yet this reference by reference, limitation by limitation analysis fails to demonstrate how the Wang reference teaches or suggests its combination with Le Grand to yield the claimed invention. Instead, the

Examiner lists several potential advantages to combining the prior art references that may only be determined by using the Applicant's disclosure as a blueprint. Thus, Applicant asserts that there is no motivation to combine these prior art references.

Even if there is a motivation to combine the prior art references the combination of Le Grand and Wang will not result in the invention as claimed. Specifically, the Examiner relies on Le Grand primarily, and on Wang for the third compartment and frusto-shaped first compartment.

Applicant asserts that neither of the references teaches three separate compartments. The specification states "wall 26 forms the bottom of compartment 18, and the two walls define a further compartment 30." (Page 2, line 31-page 3, line 2). Further, "a friction cap 46 closes the inner end 16 of body 12 to close storage compartment 48." (Page 3, lines 12-13). Thus, the Applicant has defined and claimed the compartments as having walls 26, 28 that separate and divide the enclosed space.

In contrast, Le Grand teaches a head 12 with a centrally disposed opening 13. There is no wall separating the interior of the head 12 from that of the handle 14. Likewise, Wang teaches "a space to accommodate members within the filler 203." Again, there is no wall to separate and divide the space. Even if multiple compartments can be defined by using the combination of Le Grand and Wang, at the very least, the separate compartments are not defined by first and second transverse walls wherein the first transverse wall separates the first and second compartments and the second transverse wall separates the second and third compartments. The Examiner, in Appendix A of the final rejection, shows what the Examiner considers transverse wall

1000 and second transverse wall 1001. Applicant cannot agree with the Examiner's interpretation of transverse walls. Specifically, for example only, numeral 1001 is pointing to an oddly shaped end that cannot be considered a second transverse wall. Specifically, the claim states that the second compartment is defined by the first and second transverse walls. Even if the opening that is considered clamping space 24 could be considered as two separate compartments, the bottom wall that the Examiner is considering the second transverse wall, has a semi-circular shape and therefore cannot possibly be considered a transverse wall. Thus, a first and second transverse wall do not define what would be considered a "compartment" by the Examiner. Consequently, each and every limitation of the claimed device is not present and the Applicant considers the obvious rejection overcome. Additionally, claims 4 and 7 depend on claim 1 and for at least this reason are also considered in allowable form.

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Le Grand in view of Wyler. Examiner in his argument includes Wang and thus the Applicant will assume this 103 rejection is based on Le Grand, Wang, and Wyler. The Applicant asserts that the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness because the Wyler reference is not analogous art and should not be considered in an obviousness analysis. The reference relied upon by the Examiner must either be in field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

The Wyler reference relied upon by the Examiner is not in the Applicant's field of endeavor. When regarding the field of endeavor, the present invention deals particularly with a hammer driven punch holder. (Page 1, lines 8-13). In contrast, the Wyler reference is directed toward a device for determining skin sensitivity. (Col. 1, lines 33-37). The Wyler reference is not directed toward nor does it discuss a punch holding device. Consequently, this reference relied upon by the Examiner is not in the field of the inventor's endeavor and should not be relied upon.

The Wyler reference is not reasonably pertinent to the Applicant's problem. The Federal Circuit has clarified how to determine whether a reference is reasonably pertinent to the particular problem in which the endeavor was involved as follows:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem. ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

In re Clay, 966 F.2d 656, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992). (Emphasis added); See also, MPEP § 2141.01(a).

According to the Applicant's specification, the purpose of the present invention is "to provide a punch holder and storage tool which can easily hold the driven punch by one hand at a safe distance from the hammer." (Page 1, lines 18-21). The purpose of the Wyler reference is to "provide a device for accurately measuring the sensitivity of skin

utilizing a standardized pressure element." (Col. 1, lines 43-45).

The Applicant's reference has a different purpose as compared to that of the Wyler reference. Specifically, the Applicant's reference is for providing a punch holder and storage tool which can easily hold a punch at a safe distance from a hammer, whereas the Wyler reference is for providing a device that will accurately measure the sensitivity of skin using a standardized pressure element. Therefore, Wyler solves a different problem than the claimed invention. Consequently, one skilled in the art would have less motivation or occasion to consider the reference cited by the Examiner. Because the reference relied upon by the Examiner is not in the field of the inventor's endeavor and is not reasonably pertinent to the specific problem with which the inventor is involved, the Wyler reference is not analogous and should not be considered in an obviousness analysis. Thus, because Wyler is not analogous art the Applicant asserts that the Examiner has not shown a *prima facie* case of obviousness and respectfully requests the obviousness rejection to claim 5 be withdrawn.

Even if the Wyler reference can be considered analogous art, again, the Examiner has not demonstrated why one of ordinary skill in the art would have motivation to combine Le Grand with Wyler. This time to justify the combination, the Examiner states "it would have been obvious to one of ordinary skill in the art, to have provided Le Grand in view of Wang with a threaded plug that engages the spring to adjust the compression as taught by Wyler, to allow the spring to apply a stronger force to the object the spring is biasing." As argued above, there is no motivation to combine the Le Grand and Wang references and further, there is no

teaching in Wyler that would suggest its combination with a punch holder or a wrench. Again, this is a reference by reference, limitation by limitation analysis that fails to demonstrate how one skilled in the art using these references would be able to yield the claimed invention. The only motivation that can be found to combine a device for determining skin sensitivity with a wrench or punch holder type device is found within the Applicant's specification. Thus, Applicant asserts that this is improper hindsight reasoning and that there is no motivation to combine the prior art references. Consequently, Applicant respectfully requests the determination of obviousness be withdrawn.

Even if Wyler is analogous and there is motivation within Wyler to combine it with a wrench or punch holder, Applicant asserts that Wyler cannot cure the deficiencies of Le Grand and Wang. As argued above, neither Le Grand nor Wang teaches three separate compartments. Wyler also does not teach three separate compartments that are separated by a first and second transverse walls. Instead, Wyler teaches a stop three having a rod 2 located in housing 1. (Col. 2, lines 30-35). A tension spring 4 is located within the housing 1. (Col. 2, lines 35-41). However, Wyler does not teach multiple compartments or the use of multiple transverse walls as contemplated by the claimed invention. Thus, because the combination of Wyler, Wang, and Le Grand will not provide an invention with each and every limitation of the claimed invention, the obvious rejection is considered overcome. Additionally, claim 6 is dependent on claim 5 and for at least this reason is also considered in allowable form.

In light of the above, Applicant asserts that all pending claims present allowable subject matter and Applicant

respectfully requests that the Board reverse the finding of the Examiner. A check in the amount of \$250 has been included with this appeal brief. All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'TJZ', with a large, stylized flourish extending from the end of the signature.

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TJZ/JLH/bjs

Attachment: Appendix

APPENDIX

VIII. Claims Appendix

1. (previously presented) A punch holder, comprising,
an elongated body having a forward end with an enclosed first
compartment having a shape to receive and engage a shank
of an elongated punch,
a plunger slidably mounted in the body and having a forward
end in the enclosed compartment,
a spring associated with the plunger disposed within a second
compartment and yieldingly urging the plunger into the
enclosed first compartment,
an elongated slot in the body,
a handle secured by one end to the plunger and extending
outwardly through the slot to permit manual grasping
thereof to pull the plunger rearwardly against the
spring to release the punch shank from engagement with
the plunger, or to permit the placement of a punch
within the enclosed compartment in the path of a forward
end of the plunger;
a third storage compartment disposed within the body for
receiving a plurality of punches; and
wherein the second compartment is defined by first and second
transverse walls wherein the first transverse wall
separates the first and second compartments and the
second transverse wall separates the second and third
compartments.
2. (cancelled)
3. (cancelled)

4. (previously presented) The punch holder of claim 1 wherein a threaded plug engages the spring to adjust the compression of the spring.

5. (previously presented) A punch holder, comprising,
an elongated body having a forward end with an enclosed first compartment having a shape to receive and engage a shank of an elongated punch,
a plunger slidably mounted in the body and having a forward end in the first enclosed compartment,
a spring associated with the plunger disposed within a second compartment yieldingly urging the plunger into the enclosed compartment,
an elongated slot in the body,
a handle secured by one end to the plunger and extending outwardly through the slot to permit manual grasping thereof to pull the plunger rearwardly against the spring to release the punch shank from engagement with the plunger, or to permit the placement of a punch within the enclosed compartment in the path of a forward end of the plunger; and
a threaded plug engaging the spring to adjust the compression of the spring.

6. (previously presented) The punch holder of claim 5 further comprising a third compartment disposed within the body for receiving a plurality of punches.

7. (previously presented) The punch holder of claim 1 wherein the enclosed first compartment is frusto-shaped having a flat head and tapered side walls.

8. (cancelled)

9. (cancelled)

10. (cancelled)

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None